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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/082,115	02/26/2002	Masahide Hoshino	219865US0	3520

22850 7590 12/18/2003

OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.  
1940 DUKE STREET  
ALEXANDRIA, VA 22314

EXAMINER

YU, GINA C

ART UNIT	PAPER NUMBER
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1617

DATE MAILED: 12/18/2003

16

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/082,115

Applicant(s)

HOSHINO ET AL.

Examiner

Gina C. Yu

Art Unit

1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on August 1, 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) 7-11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 4-6, 12 and 13 is/are rejected.
- 7) ☒ Claim(s) 2, 3, 14 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Election/Restrictions***

Applicant's election with traverse of claims 7-11, Groups II, III, and IV in Paper No. 5 is acknowledged. The traversal is on the ground(s) that examiner's restriction requirement is unsupported and the search can be done in a same technical field. This is not found persuasive. Examiner notes that even applicants' disclosure suggests that the claimed method of retaining water in skin can be practiced with other products. See spec., Table 5. Similarly, applicants disclose that comparative products can be used to reinforce the skin barrier functions or moisturize hair. See Tables 8 and 15. While applicants assert that the method claims can be reasonably searched in the same technical field without serious burden, examiner respectfully points out that applicants had to conduct separate experiments to test the moisture retaining ability on skin, skin barrier reinforcing function, and removing excess dryness on hair of the claimed invention, each using different comparative products which would be classified under different class and subclasses. Examiner views that while the claimed methods are generally in cosmetic/pharmaceutical technical field, restriction requirement is proper since a search for one would not be required for another.

The election requirement is withdrawn.

The restriction requirement is still deemed proper and is therefore made FINAL. Examiner notes however that pursuant to the procedures set forth in the Official Gazette notice dated March 26, 1996 (1184 O.G. 86), the process claims of making or using

patentable products will be rejoined and fully examined for patentability under 37 CFR 1.104.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 and 4-6 are rejected under 35 U.S.C. 102(b) as being anticipated by abstract Kovacs et al. (US 5932630) ("Kovacs").

Kovacs teaches a hot melt ink composition comprising triblock copolymers such as alkane-polyoxyethylene-alkane, alkane-polyoxypropylene-alkane, alkane-(PPO)-(PEO)-(PPO)-alkane, such as poly(ethylene glycol)-distearate, JEFFAMINE-distearate, or polyamide-distearate. See col. 10, lines 3 – 15. The reference teaches the organic acids with which is used to prepare the triblock copolymers. See col. 10, lines 16 – 58. See the description of polyamide-distearate on col. 9, lines 30-63, which meets the formulation of instant claim 1 and the constituents. While the prior art triblock copolymers are used for print ink composition, the recitation in the claim that the claimed invention is to be used for external application is a preamble which states intended use or the purposes of the composition. No patentable weight is thus given to the term. Similarly, examiner views that the terms "humectant" and "skin barrier function reinforcing agent" in instant claims 5 and 6, respectively, denote the intended

use or purposes of the compositions claimed therein. Claim 4 recites the intended use of the composition, for which no patentable weight can be given. See MPEP 2111.02.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kovacs.

As discussed above, Kovacs teaches alkane-polyoxyethylene-alkane, alkane-polyoxypropylene-alkane, alkane-(PPO)-(PEO)-(PPO)-alkane, such as poly(ethylene glycol)-distearate, JEFFAMINE-distearate, or polyamide-distearate. See col. 10, lines 3 – 15.

While the reference fails to specifically teach diamides having branched hydrocarbon group at R1a' and R1b' position of formula (1'), examiner views that Kovacs renders the presently claimed diamides obvious because an isomeric compounds are obvious variations of each other if they have same use. For example, compounds having tert-butyl isomers would be obvious variations if these compounds are used for same purposes. In this case, the claimed invention is a compound and use of the compound is irrelevant.

The It would have been obvious to one having ordinary skill in the art at the time of the invention to have substituted the Kovac diamide with an isomeric compound

because of expectation of similarity between the compounds, absent evidence to the contrary.

***Allowable Subject Matter***

Claim 2 is allowed.

Claims 3 and 14 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

Claims 1, 4-6, 12, and 13 are rejected.

Claim 2 is allowed.


Claims 3, and 14 are objected to.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gina C. Yu whose telephone number is 703-308-3951.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 703-305-1877. The fax phone number for the organization where this application or proceeding is assigned is 703-308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1234.

Gina C. Yu  
Patent Examiner

  
**SREENI PADMANABHAN**  
**SUPERVISORY PATENT EXAMINER**  
12/15/03